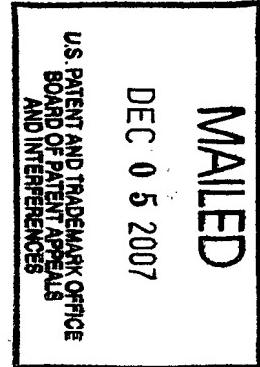


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES NADEN and FIONA WILSON

Application 10/814,897



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on November 26, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is wherewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

APPEAL BRIEF

Summary Of Claimed Subject Matter

On November 9, 2006, Appellants filed an Appeal Brief. A review of the file reveals that the "Summary of Claimed Subject Matter" does not map each of the independent claim to the specification. Further, regarding claim 40, Appellants

must provide support for the “means for” for language, as set forth in 37 C.F.R. § 41.37(c)(1)(v) which states:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Proper correction of the Appeal Brief is required.

When the Office holds the brief to be defective solely due to appellant's failure to provided a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v), an entire new brief need not, and should not be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed on November 9, 2006, defective;

- 2) notify Appellants to file a paper providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v), and properly addressing claim 40;
- 3) consider the Paper, and if necessary vacate the Examiner's Answer and supply a new Examiner's Answer in response to the Summary of the Claimed Subject matter as required by 37 C.F.R. § 41.37 (c)(1)(v); and
- 4) for such further action as may be deemed appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

Patrick J. Nolan
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571)272-9797

PJN:kis

CC: BARNES & THORNBURG LLP
 P. O. BOX 2786
 CHICAGO, IL 60690-2786